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DATE: MAY 18, 2007

NUMBER OF PAGES (INCLUDING  
THIS TRANSMITTAL COVER SHEET):

OUR REFERENCE: 231945

FROM: DENNIS R. SCHLEMMER  
REGISTRATION NO. 24,703

DIRECT LINE: 312.616-5640

TO: MAIL STOP Amendment  
 UNITED STATES PATENT AND TRADEMARK OFFICE  
 COMMISSIONER FOR PATENTS  
 ALEXANDRIA, VA 22313

FACSIMILE NUMBER: (571) 273-8300

IN RE APPLN. OF: MARK DIENER  
 APPLICATION NO. 10/520,244  
 FILED: SEPTEMBER 2, 2005  
 GROUP ART UNIT: 3724  
 EXAMINER: KENNETH E. PETERSON  
 DOCKET NO.: 231945 (Client Reference No. MEBA P003 US)

**ATTACHED PLEASE FIND THE FOLLOWING DOCUMENTS:**

- RESPONSE TO REQUIREMENT FOR RESTRICTION (2 PAGES)
- FORM PTO-1083 (1 PAGE IN DUPLICATE)

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FaxPTO (2/2006)

PAGE 1/5 \* RCVD AT 5/18/2007 5:33:57 PM [Eastern Daylight Time] \* SVR:USPTO-EFAX-3/15 \* DNIS:2738300 \* CSID:312 616 5700 \* DURATION (mm-ss):01-50

TOTAL		MINUS	37	=	x 25 =	\$	x 50 =	\$0
INDEPENDENT		MINUS	3	=	x 100 =	\$	x 200 =	\$0
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 180 =	\$	+ 360 =	\$
TOTAL AMOUNT TO BE CHARGED TO DEPOSIT ACCOUNT					TOTAL	\$	TOTAL	\$0

- ☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216.
- ☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.
- ☒ Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

LEYDIG, VOIT &amp; MAYER, LTD.

By

Dennis R. Schlemmer, Reg. No. 24,703

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Amendment or ROA Transmittal (Revised 5/9/05)

PAGE 2/5 \* RCVD AT 5/18/2007 5:33:57 PM [Eastern Daylight Time] \* SVR:USPTO-EFAX-3/15 \* DNIS:2738300 \* CSID:312 616 5700 \* DURATION (mm-ss):01-50

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FaxPTO (2/2006)

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NO. 4946 P. 2

FORM PTO-1083

**PATENT**  
Attorney Docket No. 231945  
Client Reference No. MEBA P003 US  
Date: May 18, 2007

In re Application of: Mark Diener  
Application No. 10/520,244  
Filed: September 2, 2005  
For: METAL CUTTING BAND SAW WITH SUSPENDED SAW FRAME

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a reply to office action in the subject application.

- ☐ Small entity status is claimed for this application under 37 CFR 1.27.
- ☒ Petition for an extension of time for the period noted below, as well as for any additional period necessary to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.
- ☐ Other:
- ☒ Please charge Deposit Account No. 12-1216 in the total amount indicated below. A duplicate copy of this transmittal sheet is enclosed herewith.

					SMALL ENTITY		OTHER THAN A SMALL ENTITY	
TIME EXTENSION PETITION FEE			none		\$ 0.00		\$ 0.00	
subtract time extension fee previously paid			none		(\$ 0.00)		(\$ 0.00)	
CLAIM FEE	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADD'L CLAIM FEE	RATE	ADD'L CLAIM FEE
TOTAL		MINUS	37	=	x 26 =	\$	x 50 =	\$0
INDEPENDENT		MINUS	3	=	x 100 =	\$	x 200 =	\$0
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 180 =	\$	+ 360 =	\$
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- ☒ Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

LEYDIG, VOIT & MAYER, LTD.

By

Dennis R. Schlemmer, Reg. No. 24,703

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Amendment or ROA Transmittal (Revised 5/9/05)

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NO. 4946 P. 3

FORM PTO-1083

**COPY**

**PATENT**  
Attorney Docket No. 231945  
Client Reference No. MEBA P003 US  
Date: May 18, 2007

In re Application of: Mark Diener  
Application No. 10/520,244  
Filed: September 2, 2005  
For: METAL CUTTING BAND SAW WITH SUSPENDED SAW FRAME

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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subtract time extension fee previously paid			none		(\$ 0.00)		(\$ 0.00)	
CLAIM FEE	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADD'L CLAIM FEE	RATE	ADD'L CLAIM FEE
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Amendment or ROA Transmittal (Revised 5/9/05)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Patent Application No. 10/520,244

Applicant: Mark Diener

Filed: September 2, 2005

TC/AU: 3724

Examiner: Kenneth E. Peterson

Docket No.: 231945 (Client Reference No. MEBA P 003 US bact)

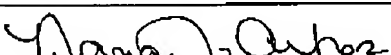
Customer No.: 23460

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## RESPONSE TO REQUIREMENT FOR RESTRICTION

Sir:

In response to the Office Action dated April 24, 2007, Applicant hereby provisionally elects Species A (Figures 1 and 2) and Group II, claims 20, 30, 31, 39, 48 and 49, subject to allowance of a generic claim.

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number <input type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input checked="" type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: (571) 273-8300.			
Name (Print/Type)	Norma J. Arhos		
Signature		Date	May 18, 2007

Application No.10/520,244

Response to Requirement for Restriction

Subject to the provisional election, Applicant hereby respectfully requests reconsideration of the requirement. While the inventions of the indicated Species may be independent and distinct, the available evidence indicates that the restriction requirement is inappropriate and that the Examiner has not set forth a prima facie case in support of the restriction requirement.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claims, and (ii) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803: "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

In this case, it is believed that any thorough and comprehensive search conducted by the Examiner of claims of either Group would include the same areas of search regardless of primary classification. The "serious burden" test for restriction would not appear to be present. Indeed, in this case, the dependent claims in various of the Groups designated by the Examiner relate to the embodiment of FIGS. 1-2 and combine in an unobvious manner to achieve the benefits of applicant's invention. A search of the prior art directed to the embodiment of the FIGS. 1-2 is believed to reasonably encompass the claimed features of that embodiment without undue burden. Accordingly, it is requested that the requirement for restriction be withdrawn, at least for the requirement of electing only some of the claims directed to the elected Species of FIGS. 1-2.

Respectfully submitted,



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Date: May 18, 2007

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